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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,433	03/23/2000	David L. Patton	80521F-P	1516

1333 7590 06/09/2006

PATENT LEGAL STAFF
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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/534,433	Applicant(s) PATTON, DAVID L.	
	Examiner Mark T. Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,14,18-23,25 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,14,18-23,25, 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 12, 14, 19-21, 23, 30-32 and 34 are finally rejected under 35 U.S.C. 102(b) as anticipated by Guttag (5,120,089) or, in the alternative, under 35 U.S.C. 103(a) as obvious in light of the teachings of Guttag in view of Denenberg (5,673,338) and further in view of Schlauch (6,082,774).

Guttag discloses in Fig. 1-5, philatelic item being a official postage stamp (see Col. 1, lines 10-42, as well as Col. 2, line 45) comprising a first visible indicia (see Col. 4, lines 3-17) which clearly is a first indicia comprising a unique ID that identifies the stamp as being one of a limited number. The stamp in Guttag further inherently includes a second indicia, which is not capable of being scanned for reproduction. For this inherency teaching, applicant is respectfully requested to review the teachings of Denenberg, which teaches a postages stamp (see Claim 9) having unique indicia (see Col. 3, lines 10-26) which is not capable of being reproduced (see Col. 3, lines 55-59; also Col. 5, lines 37-55; Col. 1, lines 28-35; and Col. 3, lines 23-26). Simple irregularities in the ink, bubbles in the ink and/or fibers of the paper, at least on of which is inherent in the stamp of Guttag, each define an “indicia” not capable of being scanned for reproduction. In as much set forth by applicant in the claim, this second indicia, inherent in Guttag, meets the claimed limitations (see MPEP 2111). Further in line with the teachings of Denenberg, the Guttag stamp inherently includes indicia which is consistent with the printer from which it was printed. It is very well known that printers are each unique and contain “flaws” or “imperfections” unique to each printer wherein the print acts as a pseudo fingerprint. This fingerprint is analogous to that of a firearm. When a bullet is fired, a unique pattern is provided on the bullet, which identifies a single firearm. In as much set forth as to the type/structure of the indicia in the claim, such “fingerprints” are inherent to the printer which forms the stamp defining the third indicia.

In the alternative, in the event applicant question the content of the first indicia of Gutttag, the use of series numbering is extremely well known in the art. Denenberg (in Col. 5, lines 45+, and in Claim 9) suggests the use of series or limited edition numbering on a stamp.

Attention is further directed to the Schlauch reference, which discloses another device having a means to identify memorabilia and collector items (see abstract). Attention is also directed to Fig. 5A, which discloses another philatelic item (see Col. 10, lines 17+) having clearly marked thereon a unique ID that indicates one of a predetermined number (see lead line 520) which clearly indicates a limited edition.

In regards to Claim 12 and 23, it would have been obvious, if not already, to one having ordinary skill in the art at the time the invention was made to provide limited edition indicia on the stamp of Gutttag as, for example, illustrated in the Schlauch reference, so as to increase the value of the philatelic item and to assure the collector as to the overall numbers of the item. As to the second indicia of the Gutttag device as discussed above, in the alternative, attention is again directed to the teachings of Denenberg, which teaches the well known concept of applying microdots to an article for authentication (see Col. 1, lines 28+, and Col. 2, lines 43+).

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to provide microdots, or, for that matter, any authentication indicia that prevents fraud, on the Gutttag stamp, for example, as discussed in the teachings of Denenberg which is to be used on postage stamps to prevent fraud and assure authenticity to a collector.

Furthermore, in regards to the second indicia being used for confirming that the stamp is a valid limited edition stamp, a recitation of the intended use of the claimed invention must result

in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the second indicia can be used a confirmation for any purposes as desired by the end user.

2. Claims 18, 22, 29 and 33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gutttag as modified by Denenberg and Schlauch as applied to claim 12 and 23 above, and further in view of Martin (5,601,683) or Burnham et al (4,884,828).

Gutttag as modified by Denenberg and Schlauch discloses a stamp comprising all the elements as claimed in Claims 12 and 23, and as set forth above.

However, Gutttag does not disclose UV ink for preventing fraudulent copies.

Martin discloses in Col. 5, lines 34-43, the use of UV ink, particularly used in the background of an item (see abstract) which prevents photocopying.

Attention is also directed to Burnham et al who discloses yet another means to prevent scanned reproduction. Burnham et al teaches the use of UV inks and the use of high frequency lines that cannot be distinguished by the naked eye and requires magnification for authentication, similar to the teachings of Denenberg.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gutttag's stamp with a second indicia, or indicia having additional copy preventing measures such as UV ink as taught by Martin or Burnham et al for preventing fraudulent copies.

In regards to **Claim 22**, the indicia provided by the teachings of either Martin or Burnham et al clearly provides first and second indicia portions, which are distinct from each other. In so doing, the distinct portion clearly provides a third indicia, which would be distinct, as discussed above, to a specific printer.

Response to Arguments

Applicant's arguments filed on March 15, 2006 have been fully considered but they are not persuasive.

In regards to applicant's argument's that the Gutttag reference does not disclose a limited edition official postage stamp, the examiner submits it would have been obvious, if not already, to one having ordinary skill in the art at the time the invention was made to provide limited edition indicia on the stamp of Gutttag as, for example, illustrated in the Schlauch reference, so as to increase the value of the philatelic item and to assure the collector as to the overall numbers of the item. As to the second indicia of the Gutttag device as discussed above, in the alternative, attention is again directed to the teachings of Denenberg, which teaches the well known concept of applying microdots to an article for authentication (see Col. 1, lines 28+, and Col. 2, lines 43+).

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to provide microdots, or, for that matter, any authentication indicia that

prevents fraud, on the Gutttag stamp, for example, as discussed in the teachings of Denenberg which is to be used on postage stamps to prevent fraud and assure authenticity to a collector.

In regards to the second indicia being used for confirming that the stamp is a valid limited edition stamp, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the second indicia can be used as a confirmation for any purposes as desired by the end user.

Therefore, the examiner has maintained the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

June 6 , 2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER